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09/993,567	11/27/2001	Chin-Wen Chou	CHOU3056/EM	7440

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EXAMINER
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PIZIALI, JEFFREY J

ART UNIT	PAPER NUMBER
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2673

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/993,567

**Applicant(s)**

CHOU ET AL.

**Examiner**

Jeff Piziali

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the specification (see Page 2, Line 1) is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-6 and 8-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The term "preventing excessive wear" in all three pending independent claims 1, 5, and 11 is a relative term which renders the claim indefinite. The term "preventing excessive wear" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. One skilled in the art would be unable to determine how much wear

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could be tolerated before crossing the "excessive wear" threshold. Furthermore, the specification leaves it unclear whether the instant invention *reduces* metal wearing or *prevents* wear entirely (see for instance, Page 3, Lines 17-20).

5. Claims 8, 16, 19, and 20 each recite the limitation "reinforced sections" in line 2. There is insufficient antecedent basis for this limitation in the claim. Which is to say, present claim language neglects to specify from what foundation the sections are being reinforced. *Reinforced* compared to what exactly?

6. The remaining claims 2-4, 6, 9, 10, 12-15, 17, and 18 are rejected under 35 U.S.C. 112, second paragraph, for simply being dependent upon rejected base claims.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-6 and 8-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Mimata (US 6,399,904 B1).

Regarding claim 1, Mimata discloses a directional switch, comprising: a base block [Fig. 8; 11] having a housing section [Fig. 2; 1] which has four ends [Fig. 2; 12] and a center disposed

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with a plurality of contact terminals [Fig. 8; 25, 35] and a common contact [Fig. 8; 21, 22, 31, 32] terminal in various directions for generating different circuit signals, and an elastic member [Fig. 2; 23] located above the common contact terminal; a control unit located in the housing section including a single conductive member [Figs. 2 and 4; 4 -- wherein it is noted that this member *conducts* force, and it is further noted that all materials conduct electricity and heat to some finite degree] extending over the plurality of contact terminals located above the elastic member, a depressing block [Fig. 2; 5] located above the conductive member and an axle rod [Fig. 4; 42] passing through the depressing block, the conductive member having pressing spots [Fig. 4; 43-45] and conducting section [Fig. 4; 41] matching the contact terminals and common contact terminal (see Fig. 8); and a lid [Fig. 2; 6] encasing the control unit and coupling with base block, and having a center opening [Fig. 2; 62] to allow the axle rod passing through; wherein the axle rod is movable in a selected direction by force to drive the depressing block depressing the conductive member such that the pressing spots and conducting section are moved downwards to connect one contact terminal and the common contact terminal for outputting a directional signal thereby to function as a directional switch; the depressing block having depress spots [Fig. 2; 53] corresponding to the pressing spots; and means [Fig. 8; 61] for preventing excessive wear [by blocking out harmful UV radiation, for instance] of the conductive member located between the depressing the conductive member block and the conductive member (see Column 5, Lines 27-65).

Regarding claim 2, Mimata discloses the depressing block has an axle opening [Fig. 2; 51(7)] to allow the axle rod passing through and a retain recess to engage with a retain flange formed on the axle rod (see Fig. 8; Column 8, Lines 11-39).

Regarding claim 3, Mimata discloses the base block and the lid have respectively a latch trough [Fig. 2; 16] and a latch section [Fig. 2; 61] engage able with each other (see Column 5, Lines 27-65).

Regarding claim 4, Mimata discloses the base block and the lid have respectively an anchor trough [Fig. 2; 16] and an anchor section [Fig. 2; 61] engage able with each other (see Column 5, Lines 27-65).

Regarding claim 5, this claim is rejected by the reasoning applied in rejecting claim 1; furthermore, Mimata discloses a lining pad [Fig. 8; 61] for preventing excessive wear [by deflecting acid rain, for instance] of the conductive member located between the depressing block and the elastic member, the lining pad having four ends each having strut and a center which has an indented section, the conductive member having an operation opening for the indented section to pass through (see Figs. 2 and 8; Column 8, Lines 11-39).

Regarding claim 6, Mimata discloses the depressing block and the lid have respectively an operation section [Fig. 2; 51(7)] and an operation trough [Fig. 2; 62] located on an inner lateral side matching with each other (see Column 5, Lines 27-65).

Regarding claim 8, Mimata discloses the depressing block has reinforced sections [Fig. 2; 53 -- wherein it is noted that these sections are reinforced compared to other thinner sections and/or sections made out of paper] located on the top surface thereof extending from the axle opening to the depress spots (see Column 8, Lines 11-39).

Regarding claim 9, Mimata discloses the housing section has a holding trough for holding the elastic member (see Fig. 8; Column 8, Lines 11-39).

Regarding claim 10, Mimata discloses the axle rod has a fasten trough for coupling with a direction control element of a mobile phone (see Fig. 2; Column 1, Lines 10-12).

Regarding claim 11, this claim is rejected by the reasoning applied in rejecting claims 1 and 5.

Regarding claim 12, this claim is rejected by the reasoning applied in rejecting claim 2.

Regarding claim 13, this claim is rejected by the reasoning applied in rejecting claim 3.

Regarding claim 14, this claim is rejected by the reasoning applied in rejecting claim 4.

Regarding claim 15, this claim is rejected by the reasoning applied in rejecting claim 6.

Regarding claim 16, this claim is rejected by the reasoning applied in rejecting claim 8.

Regarding claim 17, this claim is rejected by the reasoning applied in rejecting claim 9.

Regarding claim 18, this claim is rejected by the reasoning applied in rejecting claim 10.

Regarding claim 19, Mimata discloses the reinforced sections extend into recesses in walls of the base block (see Fig. 8; Column 8, Lines 11-39).

Regarding claim 20, this claim is rejected by the reasoning applied in rejecting claim 19.

### ***Response to Arguments***

9. Applicants' arguments filed 7 February 2005 have been fully considered but they are not persuasive. The applicants contend the cited prior art of Mimata (US 6,399,904 B1) neglects teaching using a single sheet for the conductive member (see Page 9 of the Amendment submitted 7 February 2005). However, the examiner respectfully disagrees. Mimata clearly discloses a single conductive member [Figs. 2 and 8; 4 aka 41] extending over the plurality of contact terminals [Fig. 8; 21, 22, 24, 25, 31, 32, and 35] located above the elastic member [Figs. 2 and 8; 23], as instantly claimed (see Column 5, Lines 27-65).

The applicants also contend Mimata neglects teaching a lining pad for preventing excessive wear of the conductive member (see Page 10 of the Amendment submitted 7 February



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2005). However, again, the examiner respectfully disagrees. Mimata clearly discloses a lining pad [Fig. 8; 61] for preventing excessive wear [hindering dust accumulation within the input device, for instance] of the conductive member [Figs. 2 and 8; 4 aka 41] located between the depressing block [Figs. 2 and 8; 5] and the conductive member [Figs. 2 and 8; 4 aka 41], as instantly claimed (see Column 5, Lines 27-65).

By such reasoning, rejection of the claims is deemed necessary, proper, and thereby maintained at this time.

### *Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Piziali whose telephone number is (571) 272-7678. The examiner can normally be reached on Monday - Friday (6:30AM - 3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (571) 272-7681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J.P.

20 January 2006



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